REMARKS

By the foregoing amendment, the specification has been amended to correct the translation of the groups R_a-R_f and R^2 to match that of the original German PCT text. Support for the amendments can be found in the originally filed German application received by the Patent and Trademark Office on September 14, 2001 (see Notice of Acceptance of Application Under 35 U.S.C. § 371 and 37 C.F.R. §§ 1.494 or 1.495 mailed on October 5, 2001). Thus, there is no new matter.

Claims 1-7 have been amended to further clarify Applicants' invention. In particular, R^1 of claim 1 has been amended. Support for this amendment can be found on pages 8-9 of the specification and in the originally filed German application received by the Patent and Trademark Office on September 14, 2001 (see Notice of Acceptance of Aplication Under 35 U.S.C. § 371 and 37 C.F.R. §§ 1.494 or 1.495 mailed on October 5, 2001). The structure for R_5 and R_6 has been amended in claims 1 and 2 to correct an obvious error. Claim 9 has been canceled without prejudice or disclaimer of the subject matter recited therein and new claims 16 and 17 have been added. No new matter has been added.

I. Objection To The Specification

The specification has been objected to under 35 U.S.C. § 132 because it allegedly contains new matter. Applicants submit herewith verified English translations of the original German PCT pages that correspond to the PCT pages that have been amended herein. For convenience, applicants submit herewith substitute PCT pages containing the amendments to the specification as indicated above. These show that the amendments conform the U.S. text to the original PCT text.

II. Rejections under § 112

Claim 7 has been rejected under 35 U.S.C. § 112, first paragraph. Applicants respectfully traverse this rejection.

The Examiner has stated that the "applicants disclose on P.1 of the specification that VEGF 'can be' the cause of various diseases resulting from persistent angiogenesis, which

implies that there could be causes of these diseases other than VEGF."

Applicants submit that page 1, second paragraph, of the specification does not state that VEGF can be the cause of this diseases, but instead page 1 of the specification states that "persistent angiogenesis can be the cause of various diseases such as psoriasis, . . . or can result in the progression of these diseases." Further, the third paragraph on page 1 of the specification states that a "direct or indirect inhibition of the VEGF receptor can be used for the treatment of such diseases and other VEGF-induced pathological angiogenesis and vascular permeable conditions, such as tumor vascularization." Furthermore, the last paragraph on page 1 of the specification states that "persistent angiogenesis is induced by the VEGF factor via its receptor. So that VEGF can exert this action, it is necessary that VEGF bonds to the receptor and a tyrosine phosphorylation is brought about."

Applicants are not stating that persistent angiogenesis is the only cause of the various diseases listed on page 1 of the specification. However, when persistent angiogenesis is the cause of the disease or condition it can be induced by the VEGF factor binding to its receptor. By inhibiting VEGF by, for example, inhibiting the kinase(s) (KDR or FLT) involved in VEGF receptor phosphorylation, one can inhibit persistent angiogenesis and therefore treat VEGF-mediated diseases/conditions.

Further, contrary to the Examiner's assertion that no evidence of in vitro/in vivo effectiveness is seen in the specification for any of the claimed compounds, applicants submit that pages 73-76 of the specification show the kinase inhibition IC_{50} (in μmoles) of several compounds from the examples.

In any event, to expedite prosecution and not acquiesce to the examiner's rejection, applicants have amended claim 7 to recite VEGF-mediated conditions.

Therefore, applicants respectfully request withdrawal of this rejection.

Claims 1-9 and 11-12 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification. Applicants respectfully traverse this rejection.

Section 2173.05(i) of the MPEP states that if alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*,

558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("the specification, having described the whole, necessarily described the part remaining. . . . appellants are merely excising the invention of another, to which they are not entitled, and are not creating an "artificial subgenus" or claiming "new matter."). Applicants in the specification describe in positive terms anthranilic acid amides. Thus, the exclusion of one or more of these compounds is proper under *Johnson* and MPEP § 2173.05(i).

Therefore, applicants respectfully request withdrawal of this rejection.

Claim 9 has been rejected under 35 U.S.C. § 112, second paragraph. This rejection is rendered moot in light of the cancellation of claim 9.

III. Rejections under § 103

Claims 1-6 and 8 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ozaki et al. (U.S. Patent No. 5,716,993) and Schipper. Applicants respectfully traverse these rejections.

The Merck v. Biocraft decision cited by the Examiner has been explicitly stated not to hold that overlap always establishes obviousness. See *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992) and *In re Baird*, 16 F.2d 380, 29 USPQ2d 1550 (Fed. Cir. 1994). In Baird, a very broad disclosure, similar to that in Ozaki et al. and Schipper, was held not to render obvious all the compounds included within the scope of its very broad Markush disclosure. Rather, the only portion of the reference which could realistically teach a skilled worker anything of significance, was found to be its examples. All of these taught away from the claims of the Baird et al. application. Consequently, the broad prior art disclosure did not render the claims obvious. The same analysis used in *In re Baird* can be applied to Schipper and Ozaki et al.

Even if Schipper discloses a genus of ovrlapping compounds, none of the disclosed compounds in the examples are within applicants' genus. For example, R^1 in all the compounds disclosed in the examples of Schipper is either H or alkynyl, despite the large genus of R^1 groups very broadly disclosed in its column 1. Such exemplified compunds are very different from the instantly claimed compounds. Further, there is nothing in Schipper

which would motivate a skilled worker to make the changes necessary to the specified disclosed compounds in order to arrive at the claimed compounds. Without such motivation, there can be no obviousness. *In re Jones* above.

As for Ozaki et al., again, the mere possibility of an overlap does not establish obviousness. Instead, one must look to the examples of such an extremely broad disclosure to find effective teachings for purposes of 35 U.S.C. §103. As the Examiner has already noted, even within the prior broadly interpretable claims of this application, only a single example of Ozaki et al. was relevant. This example is still excluded from the claims of this application under the foregoing amendments which now more specifically define R^1. Importantly, all of the 144 examples of Ozaki et al. require that the structure of this invention represented by XYR^3 be a moiety not possible for this invention (i.e., be a -NR-CO group), except for examples 33 and 48. But the latter both require a 3, 4-methylenedioxybenzyl group in the R^1 position of this invention. The latter is not possible within the claims of this application. Thus, even if one were to ignore the strong teaching of 142 of the 144 Ozaki et al. examples and employ a -W-A-Z group of this invention, Ozaki et al. informs the skilled worker only that the R^1 group must be one other than permitted by this invention. Thus, the only feasible teachings of Ozaki et al., in all cases, lead away from this invention. See the Jones decision above which explicitly states that one must consider all structures of prior molecules when determining the relationship of a molecule to a claimed invention. Under Jones, and for the reasons stated, it is respectfully submitted that Ozaki et al. does not render any of the claims obvious, and, in fact, teaches away from them. Further, there is no teaching or suggestion anywhere in Ozaki et al. to modify any of the disclosed compounds to arrive at applicant's invention. Accordingly, without such motivation, Ozaki et al. does not render the claims obvious.

As can be seen, both references, alone or in combination, fail even to suggest the claims of this application.

It appears the Examiner's argument is based on an "obvious to try" modification. However, Applicants remind the Examiner that an "obvious to try" modification is an insufficient basis to modify or combine references and that one cannot base a determination of obviousness on what the skilled artisan might try or find obvious to try.

The burden is on the Examiner to point out the suggestion, teaching or motivation from the cited references that would have led a person of ordinary skill in the art to modify the disclosed compounds to arrive at the claimed invention. This has not been done.

Therefore, Applicants respectfully request withdrawal of the rejections of claims 1-6 and 8 under 35 U.S.C. § 103(a).

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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